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Pekka Ketola

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EXAMINER

ALVESTEFFER, STEPHEN D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,678

Applicant(s)

KETOLA ET AL.

Examiner

Stephen Alvesteffer

Art Unit

2175

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-16,18-30 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-16,18-30 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is responsive to the Request for Continued Examination (RCE) filed June 2, 2009. Claims 1, 15, 23-25, 30, 35, and 39 are amended. Claims 4, 17, 31, and 32 were previously cancelled. Claims 1, 15, 30, and 39 are independent. Claims 1-3, 5-16, 18-30, and 33-39 remain pending.

Claim Objections

Claim 30 is objected to because of the following informalities: In line 8, "traced and **recorder** items" should be corrected to —traced and **recorded** items—. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The meaning of limitation "detecting a latest operation relating

to a source application of at least one source application” is not understood and cannot be found in the specification.

Regarding claim 39, the claim limitation “*means, being common to all of said at least one source application, for tracing an item relating to said operation from the source application automatically right after said operation has occurred, extracting at least on item from said operation, and recording said item into a list of traced and recorded items in a file automatically, said list comprising traced and recorded items from various source applications*” (emphasis added) uses the phrase “means for” or “step for”, but it is modified by some structure, material, or acts recited in the claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase “means for” or “step for” is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase “means for” or “step for”).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-16, 18-30, 33, 34, and 37-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson, United States Patent 6,005,928.

Regarding claim 1, Johnson teaches a method comprising:

detecting a latest operation relating to a source application of at least one source application (see Johnson column 3 lines 29-37; *"As a page is received, the caller ID number of the person initiating the page is captured by the pager service, using known ANI (automatic number identification) techniques, or the like"*),

automatically tracing an item relating to said operation from the source application by means of a tracing application being common for all of said at least one application right after said operation has occurred (see Johnson column 1 line 54 through column 2 line 7; *"The history of distributions, including phone calls, phone mail, pager notifications, fax jobs, and print jobs, or the like, is saved in first-in-first-out order"*; see also Johnson column 3 lines 20-28; *"In the preferred embodiment, each platform, for example PC 104, PBX 114, pager system 118, contains a platform dependent set of application programming interfaces (API) for accessing the enterprise AB 120 and writing information to the AAD 122. The AB 120 is preferably a single shared repository whereby each platform has a particular native communications interface to the AB 120.*

Likewise, the AAD 122 is preferably a single repository that is accessed from various components of the present invention”),

extracting at least one item from said operation (see Johnson column 3 lines 37-45; *“As phone calls are received or a voice mail message is recorded, the caller ID number is captured, via PBX 114 signals, ANI, or the like. For calls that complete successfully, the caller ID is used by the phone system manager 144 as a key to access data within the AB 120 and the corresponding person’s name and addressing information is retrieved”*),

recording said item automatically into a list of traced and recorded items in a file of the tracing application, said list comprising traced and recorded items from various source applications (see Johnson columns 1-3; where the Automatic Addressing Database (AAD) of Johnson is equivalent to applicants’ the list of traced and recorded items in a file, and where “distributions” of Johnson are traced and recorded from various source applications),

calling said file by the target application (see Johnson Abstract; *“The system also permits the recipient to paste information about the sender directly into arbitrary applications on his computer”*), and

selecting and pasting said one or more items to said target application (see Johnson column 4 line 54 through column 5 line 5; *“the present invention allows a user to automatically retrieve address book data (e.g., addressing information) into an application running on the user’s computer with the use of a graphical user interface (GUI), or hot keys. For example, assume the user has recently received a telephone*

call. The user can move the cursor on screen and paste the name of that recent caller, paste the caller's E-mail ID, paste the caller's phone number, paste the caller's fax number, paste the caller's pager number, or paste the caller's LAN address directly into a file, or application, that is open on the user's computer").

Regarding claim 2, Johnson teaches that the item is selected from the file by means of a clipboard (see Johnson column 5 lines 1-5; *"the information associated with the caller can be inserted into any application on the user's computer that supports conventional cut and paste clipboard functions"*).

Regarding claim 3, Johnson teaches that more than one operations are traced and recorded (see Johnson column 3 lines 51-60; *"The user will also specify an AAD depth N for maintaining a historical collection of addressing information associated with received distributions. The last N distributions are historically collected"*).

Regarding claim 5, Johnson teaches that the file is a log file (see Johnson column 1 line 54 through column 2 line 7; *"The history of distributions, including phone calls, phone mail, pager notifications, fax jobs, and print jobs, or the like, is saved in first-in-first-out order"*, where the saved history of distributions is equivalent to a log file).

Regarding claim 6, Johnson teaches that at least one of the following operations: handling, receiving, sending, downloading, creating, deleting, is traced (see Johnson column 1 line 54 through column 2 line 7; *"The history of distributions, including phone calls, phone mail, pager notifications, fax jobs, and print jobs, or the like, is saved in first-in-first-out order"*).

Regarding claim 7, Johnson teaches that said item is a content of the operation or a property of the operation (see Johnson column 4 lines 6-12; *"The E-mail manager 132 inserts entries into the AAD 122 based on received E-mail distributions in an E-mail application. The source address is captured and used as a key to access data within the AB 120 and the corresponding person's name and addressing information is retrieved"*).

Regarding claim 8, Johnson teaches that the source application and the target application are located within one application program (for example, addressing an e-mail in response to a recently received e-mail. see Johnson column 1 lines 35-45).

Regarding claim 9, Johnson teaches that the source application and the target application are located in different application programs (for example, paging someone in response to a recently received e-mail. see Johnson column 1 lines 35-45).

Regarding claim 10, Johnson teaches that the source application and the target application are located in different devices (for example, a paging system contacting a the computer system. See Johnson Figure 1).

Regarding claim 11, Johnson teaches that said file is shared between application programs of a computing device (see Johnson column 3 lines 20-28; *"the AAD 122 is preferably a single repository that is accessed from various components of the present invention"*).

Regarding claim 12, Johnson teaches that a media type of the item is identified (see Johnson column 5 lines 54-67; *"A "services to track" (SVCS2TRK) field 218 includes a bit mask corresponding to those distributions that the particular user configured to be tracked for automatic distribution addressing"*).

Regarding claim 13, Johnson teaches that said media type belongs to one of the following groups: image, audio, video, text, uniform resource location, phonebook entry, music, calendar event, wallet and error message (see Johnson column 5 lines 54-67; *"the distributions to track include: pager bit, printed bit, an fax bit, a E-mail bit, and phone call/mail"*).

Regarding claim 14, Johnson teaches that said media type is used for classifying the item (see Johnson column 5 lines 54-67; *"A "services to track" (SVCS2TRK) field 218 includes a bit mask corresponding to those distributions that the particular user configured to be tracked for automatic distribution addressing"*).

Claims 15, 16, and 18-26 recite a device with substantially the same limitations as the method of claims 1-3 and 5-14. Therefore, the claims are rejected under the same rationale.

Regarding claim 27, Johnson teaches that the device is further configured for manual copying (see Johnson column 7 lines 7-18; *"A user can actually drag and drop from the window or copy an entry from that window to a clipboard"*).

Regarding claim 28, Johnson teaches that the device is further configured for mobile communication (see Johnson column 3 lines 61-67; *"Participating services are applications that can execute as the result of a desktop computer, a laptop computer, or a PDA (personal data assistant)."*).

Claim 29 recites a system for implementing the method of claim 1. Therefore, claim 29 is rejected under the same rationale as claim 1.

Claims 30 and 33 recite a computer program product with substantially the same limitations as the method of claim 1. Therefore, the claims are rejected under the same rationale.

Regarding claim 34, that a media type of said item belongs to one of the following groups: image, audio, video (see Johnson column 1 line 54 through column 2 line 7; *"The history of distributions, including phone calls, phone mail, pager notifications, fax jobs, and print jobs, or the like, is saved in first-in-first-out order"*).

Regarding claim 37, Johnson teaches that said file comprises items of different media types (see Johnson column 1 line 54 through column 2 line 7; *"The history of distributions, including phone calls, phone mail, pager notifications, fax jobs, and print jobs, or the like, is saved in first-in-first-out order"*).

Regarding claim 38, Johnson teaches that said operation is a phone call and said item is a phone number; or said operation is a camera shot and said item is an image; or said operation is a site downloaded from a network and said item is the URL of the site (see Johnson column 3 lines 37-46; *"As phone calls are received or a voice mail message is recorded, the caller ID number is captured, via PBX 114 signals, ANI, or the like"*).

Claim 39 recites a device having substantially the same limitations as the method of claim 1. Therefore, claim 39 is rejected under the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (6,005,928) *supra* and Goh et al. (hereinafter Goh), United States Patent Application 2006/0155811.

Regarding claim 35, Johnson teaches every limitation of claim 35 except that said target application is a multimedia messaging service message. Goh teaches a mobile device with clipboard features and makes use of Multimedia Messaging Service (MMS) for viewing images (see Goh paragraph [0053]; *"The example embodiment further comprises file conversion techniques for the user to convert an attached file in a*

received email to an image file format or text format. For example, the resultant image file can be viewed via Multimedia Messaging Service (MMS), while the resultant text can be viewed via WAP"). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide MMS messaging support as taught by Goh in the invention taught by Johnson as a design choice to support the newer multimedia MMS format for messaging.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (6,005,928) *supra* and Kumar, United States Patent Application 2005/0028008.

Regarding claim 36, Johnson teaches every limitation of claim 36 except that the method further comprises presenting said item in a list utilizing a check-box feature for selecting. Kumar teaches utilizing a check-box feature for selecting files to paste from a clipboard (see Kumar paragraph [0114]; *"Paste File(s) from Clipboard: This function allows the user to paste or insert all the selected files (via checkbox) to the selected Folder"*). Both Kumar and Johnson utilize a clipboard for pasting multiple items. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a check-box feature for selecting files to paste as taught by Kumar in the invention of Johnson to provide a standard way of selecting several items at once.

Response to Arguments

Applicants assert that Johnson does not disclose any "tracing application" being common to other applications the operations of which are being traced. The examiner respectfully disagrees.

It is noted that the recited claim language only requires detecting a single operation relating to a single source application. The claims make no reference to "other applications". For example, claim 1 recites "a tracing application being common for **all of said at least one** application" (emphasis added). "all of at least one" can be reasonably interpreted as "one".

As evidence that Johnson does not disclose any tracing application being common to other applications, applicant notes, *"in Johnson at column 3, lines 20-28, it is disclosed that each platform (e.g., PC, PBX, pager) contains a platform dependent set of application programming interfaces (API's) for accessing the enterprise address book (AB) and writing information to the automatic addressing database (AAD)".* However, this disclosure does not mean that each application has its own tracing application, or that there is no tracing application at all. The cited passage discloses that many different devices (such as PC, PBX, or pagers) can be adapted to Johnson's invention by making use of *"a platform dependent set of application programming interfaces"*. It is known to persons of ordinary skill in the art that an application programming interface is not an application in itself, but rather a set of functions that an application can use to request services of a common application (such as a tracing application). In fact, Johnson column 3 lines 20-28 goes on to disclose, *"The AB 120 is*

preferably a single shared repository whereby each platform has a particular native communications interface to the AB 120. Likewise, the AAD 122 is preferably a single repository that is accessed from various components of the present invention". This clearly teaches that every application of the system might share the same traced information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Baker et al. (US 7,076,738) Computer device, method and article of manufacture for utilizing sequenced symbols to enable programmed application and commands

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Alvesteffer whose telephone number is (571)270-1295. The examiner can normally be reached on Monday-Friday 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on (571)272-4088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stephen Alvesteffer
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